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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,856	11/01/2001	Quynh T. Pham	J6655(C)	9814

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EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/044,856	PHAM ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Examiner acknowledges receipt of remarks and amendment after final. Claims 8 and 10-16 are pending.

1. Upon further consideration of the pending claims, the finality of the rejection of the last Office action is withdrawn.
2. The indicated allowability of claims 8 and 10-14 is withdrawn in view of the issues raised below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for amphipathic block copolymer and hydrophobically modified polymers such as polymeric emulsifiers (see paragraphs [0029] to [0036] of the published instant disclosure), does not reasonably provide enablement for all wetting agents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In this case, applicants seek protection for composition that contains wetting agent. However, amphipathic block copolymer and hydrophobically modified polymers such as polymeric emulsifiers are the wetting agents enabled by the disclosure and thus, the scope of enablement provided to one skilled in the art by the disclosure is not commensurate with the

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scope of protection sought by the claims. *Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003); *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). See also *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003). Other wetting agents are disclosed in following references, cited as teaching references:

A. Kigasawa et al. (US 4,952,560, column 4, lines 37-64) discloses wetting agents as including polyhydric alcohols and amino acids as representative examples. “The polyhydric alcohols include glycols, triols and polyols having 4 to 6 alcoholic hydroxyl groups.” “The amino acids include various amino acids commonly known as natural amino acids. The glycols include alkylene glycols containing 2 to 6 carbon atoms, e.g., ethylene glycol, propylene glycol, butylene glycol, etc.; polyethylene glycol having average molecular weight of about 200 to 8,000, preferably 200 to 6,000, etc.; said triols include glycerin, trimethylolpropane, etc.; and said polyols include sorbitol or sorbit, etc. In particular, the said alkylene glycol, polyethylene glycol, glycerin and sorbitol are preferably used.” Mixture of the agents listed above also meets the concept of wetting agent in Kigasawa.

JP 2001309986 (English abstract) lists urea, polyhydric alcohol, lactic acid or its salt as wetting agent.

JP 63313709 (English abstract) lists polyhydric alcohols such as glycerine, propylene glycol, polyethylene glycol, sorbitol, dl-pyrrolidone carboxylic acid salt and xylitol as wetting agents.

JP 63216815 (English abstract) discloses a wetting agent to be a mixture of glycerol, 2-4C alcohols and polysaccharide and their derivatives.

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Thus the scope of enablement provided to one skilled in the art by the disclosure is not commensurate with the scope of protection sought by the claims. And one skilled in the art is not enabled to make and use the entire scope of the claimed invention without undue experimentation because the claimed wetting agent is broader than the enabled amphipathic block copolymer and hydrophobically modified polymers such as polymeric emulsifiers wetting agent disclosed in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 8 and 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claims is unclear because, claim 8 consists essentially of (a), (b), (c) and (d); and consist essentially of excludes any components that would materially affect the novel characteristic of the claimed invention. Here, claim 10 further optionally includes volatile silicone oil; claim 11 further optionally includes fluid oil; claim 12 further optionally includes crystalline fatty acid; and new claim 16 further optionally includes an oil. These optional ingredients appear to materially affect the novel characteristic of claim 8 as recited because these optional ingredients affect skin feel, consistency, occlusion and emolliency.

Secondly, the polyhydric alcohol in claim 15, which depends on claim 8, is present in amount of from about 30% to about 99.75% while the upper limit of the polyhydric alcohol in claim 8 is 90%. 99.75% is outside the scope of 90%. Thus claim 15 does not further limit the scope of the polyhydric alcohol of claim 8 upon which claim 15 depends from.

Response to Arguments

7. Applicants' arguments, see pages 5 and 6, filed 02/28/05, with respect to claims 1, 3-7 and 15 have been fully considered and are persuasive in light of the cancellation of the claims. The rejection of claims 1, 3-7 and 15 is moot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600

